

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Application No. : 10/758,241 Confirmation No. : 5324
First Named Inventor : Bernd SUNDERMANN
Filed : January 16, 2004
A.U. : 1609
Examiner : Kristie Latrice Brooks

Docket No. : 029310.53093US
Customer No. : 23911

Title : Substituted 4-Aminocyclohexanol Compounds

REPLY TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a reply to the Office Action mailed May 3, 2007, in the above-identified patent application.

Responsive to the requirement for restriction, applicants hereby provisionally elect the claims of Group I, namely, claims 1-38, which are directed to a substituted 4-aminocyclohexanol compound. This provisional election is made *with* traverse.

The requirement for restriction is respectfully traversed because it is based upon an erroneous premise. The restriction is assertedly justified on grounds that the special technical feature which links the groups of claims is not novel. This premise, however, is **not** correct.

As noted in the Office Action, the claims of all groups are linked by the structure of Formula I. Pointedly, the entire structure of Formula I must be considered, not merely a portion of the compound. Thus, the substituent groups, or "R" groups, cannot be left out of consideration.

When Formula I is properly considered in its entirety, it is apparent that the structure of Formula I defines a contribution over Lednicer, US 4,366,172, because the Lednicer compounds all include a phenyl group in the 4-position of the cyclohexanol ring, whereas in the presently claimed invention, R³ (the substituent in the 4-position of the cyclohexanol ring) is **never** a phenyl group.

Accordingly, the compounds of Formula I, properly considered as a whole, define an inventive contribution over the state of the art and properly link the groups of claims. Reconsideration and withdrawal of the restriction requirement are therefore respectfully requested.

Responsive to the requirement for election of species, applicants hereby elect the compound of Example 4, namely, 4-benzyl-4-dimethylamino-1-phenethyl-cyclohexanol hydrochloride, which corresponds to a compound of Formula I in which R¹ and R² are each methyl, R³ is benzyl and R⁴ is 4-fluorophenethyl. Claims 1, 3-5, 8-13, 19-29, 31-33 and 36-53 are deemed to read on the elected species.


Favorable action on this application is earnestly solicited.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned attorney at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to our Deposit Account No. 05-1323 (Docket # 029310.53093US).

Respectfully submitted,

June 1, 2007


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